FILED

IN THE

Supreme Court of the United States

—— TERM, 1973

No. 73-1655

PARKER SWEEPER COMPANY,

Petitioner,

v.

THE E. T. RUGG COMPANY,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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INDEX

	PAGE
Opinions Below	1
Jurisdiction	2
Question Presented	2
Statutes Involved	2
Statement of the Case	3
Reasons for Granting Certiorari	7
I. The Question Presented Is of Importance in the Interpretation of the Patent Laws	7
II. The Decision Below on the Question of Obviousness Was Inconsistent with Fundamental Principles Applied by the Sixth Circuit Itself	11
III. The Decision Below on the Question of the Statutory Presumption of Validity Was Inconsistent with Fundamental Principles Applied by the Sixth Circuit Itself	13
Conclusion	14
Appendix A, Decision of District Court below	1a
Appendix B, Decision of Court of Appeals below	16a
Appendix C, The Patent Laws involved	29a

TABLE OF CASES

PAGE

FMC Corporation v. F. E. Myers & Bro. Co., 384 F.2d 4 (6th Cir. 1967), cert. den. 390 U.S. 988 (1968) 13

Graham v. John Deere Co., 338 U.S. 1 (1966) 8

H. K. Porter Company v. Goodyear Tire & Rubber Company, 437 F.2d 244 (6th Cir. 1971), cert. den. 404 U.S. 885 (1971) 12

Kolene Corporation v. Motor City Metal Treating, Inc., 440 F.2d 77 (6th Cir. 1971), cert. den. 404 U.S. 886 (1971) 12

Panduit Corporation v. Stahlin Bros. Fibre Works, Inc., 430 F.2d 221 (6th Cir. 1970), cert. den. 401 U.S. 939 (1971) 13

United States Gypsum Co. v. Dale Industries Inc., 383 F.2d 497 (6th Cir. 1967) 13

Westwood Chemical, Inc. v. Owens-Corning Fiberglas Corp., 445 F.2d 911 (6th Cir. 1971), cert. den., 405 U.S. 917 (1972) 12, 13

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Petitioner PARKER SWEEPER COMPANY prays that a writ of certiorari be issued to review that part of the judgment of the United States Court of Appeals for the Sixth Circuit entered in the case of *PARKER SWEEPER CO.* v. *E. T. RUGG CO.* on February 27, 1973 that reversed the judgment of the United States District Court for the Southern District of Ohio, Eastern Division, holding Petitioner's United States Patents Nos. 3,035,294 and Des. 194,051 valid.

OPINIONS BELOW

The as yet unreported opinion of the District Judge is appended hereto at pages 1a-15a, as Appendix A. The

opinion of the Court of Appeals for the Sixth Circuit, __ F.2d __, 177 USPQ 161 (6th Cir. 1973), is appended hereto at pages 16a-28a, as Appendix B.

JURISDICTION

The judgment of the Court of Appeals was entered on February 27, 1973; Petitioner's Petition for Rehearing, characterized by the clerk of the Court of Appeals as "motions for rehearing and rehearing in banc" was denied on April 16, 1973. The jurisdiction of this Court is invoked under Section 1254(1) of Title 28, United States Code, June 25, 1948, c. 646, 62 Stat. 928.

QUESTION PRESENTED

In view of the statutory presumption of validity (35 U.S.C. 282) which attaches to an issued United States patent, should a Court of Appeals substitute its opinion respecting obviousness (35 U.S.C. 103) for that of the District Judge when the District Judge has arrived at his opinion by applying the test for obviousness laid down by the Supreme Court in *Graham* v. *John Deere Co.*, infra, to the factual evidence before him, which evidence included the testimony of expert witnesses, and as to which evidence he made careful findings of fact, all of which findings were fully accepted by the Court of Appeals?

STATUTES INVOLVED

The specific patent statutes involved are Title 35, Patents, Act of July 19, 1952, c. 950, sec. 1, 66 Stat. 792, especially 35 U.S.C., Sections 101 (66 Stat. 797), 102 (66 Stat. 797 and, as amended July 28, 1972, 86 Stat. 502), 103 (66 Stat. 798) and 282 (66 Stat. 812 and, as amended July 24, 1965, 79 Stat. 261), with emphasis on sections 103 and 282. All of these statutes are set forth at p. 29a et seq. as Appendix C.

STATEMENT OF CASE

This case is one for patent infringement in which the validity of the patents was challenged. Federal jurisdiction in the District Court, the court of first instance, as to the parties involved and the subject matter, was in accordance with Title 28 U.S.C. 1338(a) (62 Stat. 931 and, as amended Dec. 24, 1970, 84 Stat. 1559) and 1400(b) (62 Stat. 936) and under the patent laws of the United States, Title 35, U.S.C., sections 101, 102, 103 and 282 (also 271, 283, 284 and 285), as set forth in Appendix C at p. 29a et seq.

Petitioner, PARKER SWEEPER COMPANY, is an Ohio corporation and the owner of the patents in suit, namely, United States Patents Nos. 3,035,294 and Des. 194,051 (Exhibits 5 and 6—App. pp. 6 and 10)* relating to the structure and appearance, respectively, of a trailing dumpable lawn sweeper design to be pulled behind a home garden tractor to pick up leaves and debris and later dump them on a trash pile (p. 2a).*

The lawn sweeper covered by the patents in suit comprises a cart frame having a pair of spaced upright side sections with axle means at the front and rear, such axle means supporting ground engaging wheels; and a rotary work element carried by the front of the frame and arranged to sweep debris into an open top and open front debris receptacle which is pivotally mounted between the frame sections; the pivotal support for the receptacle being so arranged that it is forward of the receptacle center of gravity so that when an operator, sitting on the tractor seat, pulls the cord attached to the top of the receptacle, the receptacle will dump the debris therefrom

* "Exhibits" refer to those introduced in the District Court; "App." refers to the Appendix filed in the Court of Appeals; "Record" refers to items introduced in the District Court but not reproduced in the Appendix; and "p. —a" refers to pages of those Appendixes appended hereto.

and will automatically return to its debris-receiving position when the operator releases the cord (p. 2a).

Respondent, THE E. T. RUGG COMPANY, manufactured for Sears, Roebuck & Company a trailing dumpable lawn sweeper which appeared to both the District Judge and to the Court of Appeals to have been deliberately copied from Petitioner's commercially successful product (p. 17a).

The Parker sweeper of the patents in suit was developed in about 1960 (App. p. 108). There were no other trailing dumpable lawn sweepers available on the market when Petitioner Parker introduced its sweeper, which embodied the teachings of the patents in question, to the market in 1960 (p. 4a). (Respondent did not enter this market until 1966—pp. 4a and 18a.)

The problem of lawn debris removal had existed for many years and prior to 1960 other arrangements were tried; first, an end-over dumpable sweeper; second, a sweeper with a fixed basket but having a removable bailing liner; third, a sweeper with a removable basket; fourth, a towable sweeper with a bailing liner (two persons were needed to handle it); and fifth, a towable sweeper with a basket pivoted on trunnions for side dumping (one person could handle it but he had to get off the tractor); these arrangements, however, were not suitable for the home market—more was needed (all at App. pp. 101-103 and p. 17a).

Petitioner's patented sweeper when introduced in 1960 was a prompt and substantial success as noted by both the District Judge and the Court of Appeals (pp. 4a and 18a).

Respondent Rugg challenged the validity of the patents in suit on the basis of nine (App. pp. 207-208) patents (Exhibits A-4, 6, 10, 11, 15, 22, 23, 25 and 27, copies reproduced at App. pp. 32, 36, 40, 45, 54, 69, 76, and 85).

All of these nine patents relied upon by Respondent as indicating the state of the prior art were classified by the United States Patent Office in the same classes and subclasses as were the patents cited by the Patent Office Examiner during the prosecution of the application of the patents in question (p. 8a) and were undoubtedly considered by the Examiner during his search (p. 8a). These patents were selected by Respondent from an original list of 28 patents, counsel for Respondent stating that those patents not selected, which included those actually cited by the Examiner, were no more important and only cumulative (App. pp. 207-208).

Five of the nine patents constituting the prior art relied upon by Respondent as being in anticipation of the patents in suit issued in the period 1891 to 1902; the four most recent issued in the period 1948 to 1956 (p. 6a).

The Patent Office considered the inventions of the patents in suit from the standpoint of obviousness; indeed, it initially rejected certain claims "as being obviously fully met" (Record, Exhibit 3, p. 15, Office Action Feb. 25, 1960 paragraphs 3 and 4), a rejection which it eventually withdrew as evidenced by the allowance of the patents.

The District Judge heard expert testimony concerning the nine prior art patents relied upon by Respondent; this testimony included Respondent Rugg's expert (App. pp. 181-199 and 217-225) and Petitioner Parker's expert (App. pp. 234-250). Additionally, the uncontroverted testimony of Petitioner's expert is that it would not have been obvious to him to proceed from these prior art patents to "this unique device, this sweeper" of the patents in suit (App. pp. 238, 240-241 and 246-247).

Based on the foregoing testimony, which is referred to by the District Judge (see, for example, p. 7a), the District Judge made, to use the language of the Court of Appeals, "careful findings of fact" (p. 18a), concerning

all of these prior art patents, see especially Findings of Fact 17 (p. 5a et seq.), in which dissimilarities were noted between this prior art and the patents in suit.

The District Judge also made the following pertinent findings of fact:

(8) There were no other trailing dumpable lawn sweepers available when Petitioner Parker introduced its sweepers, which embodied the teachings of the patents in question, to the market in 1960 (p. 4a).

(9) Commercially the sweepers were a prompt and substantial success (p. 4a).

(17a) The four most recent patents (A-22, A-23, A-25 and A-27) each concerned manually pushed lawn sweepers with fixed debris receptacles; they suggested only the need for a better way to remove lawn debris (p. 6a). (These four patents issued in the period 1948-1955.)

(17b) The five old patents relate to horse-drawn street sweepers (A-4 and A-10), manually pushed street sweepers (A-6 and A-11), and an attachment for a lawn mower (p. 6a et seq.). (These five patents issued in the period 1891-1902.) These five patents are described, with reference to expert testimony, and in each case significant dissimilarities are found with respect to the sweeper of the patents in suit (p. 6a et seq.).

(18) The nine patents relied upon by Respondent Rugg were such as to have been considered by the Patent Office (p. 8a; see also p. 6a).

The District Judge concluded that the patents in suit were valid (pp. 8a and 11a).

In its opinion, the Court of Appeals accepted all of the following:

(a) The "careful" findings of the District Judge—they "certainly" are *not* "clearly erroneous" (p. 18a).

(b) The facts that the Parker sweeper met the test of utility fully and it passed the test of novelty (p. 18a).

(c) The District Judge's statement of the law applicable to a determination of obviousness (p. 18a).

(d) The applicability of the secondary considerations, e.g., a long felt want of which Respondent Rugg as a manufacturer of lawn mowers would have been at least cognizant of but which, despite the existence of the 19th century sweepers, was not filled until Petitioner Parker developed the sweeper of the patent in suit in 1960 (p. 20a), and the "skyrocketed" sales which resulted, the best evidence as to commercial success (pp. 18a and 20a).

(e) The presumption of validity (p. 20a).

The Court of Appeals, in reversing the District Judge, concluded, as a matter of law, that the Parker sweeper patent was invalid because the record demonstrated a failure to meet the nonobviousness test of 35 U.S.C. 103 (p. 25a).

REASONS FOR GRANTING CERTIORARI

I. The Question Presented Is of Importance in the Interpretation of the Patent Laws.

This Supreme Court, in the exercise of its sound judicial discretion, should settle the question of how much weight is to be given the statutory presumption of validity, particularly when both the Patent Office, in considering the obviousness or nonobviousness of the invention in the first instance, and the District Judge in considering the obviousness or nonobviousness of the invention in the second instance, based on evidence adduced at trial, conclude that the subject matter of the invention as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

The Patent Laws set forth three fundamental criteria for the granting of a patent on a machine: (a) the machine must be useful, 35 U.S.C. 101 (p. 29a); (b) the machine

must be novel, 35 U.S.C. 102 (p. 29a); and (c) the machine must not have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains, 35 U.S.C. 103 (p. 30a).

The Court of Appeals below stated: "We agree with the District Court that Parker's lawn sweeper passed the first two tests of novelty and utility. It still must pass the test of Sec. 103 which provides . . .".

In *Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18 (1966), the Supreme Court established the test for obviousness:

> "[11] While the ultimate question of patent validity is one of law. A. & P. Tea Co. v. Supermarket Corp., supra, 340 US at 155, 95 L ed at 168, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances * surrounding the origin of the subject
>
> * [383 US 18]
>
> matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. See Note, Subtests of "Nonobviousness": A Nontechnical Approach to Patent Validity, 112 U Pa L Rev 1169 (1964)."

The District Judge did indeed follow this test for determining "obviousness" (p. 9a) and the Court of Appeals specifically recognized this fact (pp. 18a to 20a):

> "As we have indicated, we also agree with the District Judge that the Parker sweeper met the test of

utility fully and had sufficient differences in its method of combination of previously known elements to pass the test of novelty.

"Nor do we find any fault with the District Judge's statement of the law applicable to a determination of 'obviousness':

> 'A three-step test has been established by the Sixth Circuit in determining the question of what constitutes "obviousness." *Westwood Chemical, Inc.* v. *Owens-Corning Fiberglas Corp.*, 445 F.2d 911 [6th Cir. 1971]. The first step is a factual determination of the prior art; second, a factual determination of what, if any, improvement the patentee has made over the prior art; and third, a legal question of whether the improvement would have been obvious to one skilled in the art. Additionally, the Supreme Court in *Graham* v. *John Deere Company*, 383 U.S. 1 (1965), has indicated secondary considerations such as commercial success, long felt but unsolved needs, failures of others, etc., as relevant indicia of obviousness or non-obviousness. Such secondary considerations might also be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.'

"The rationale of the District Judge and of the appellees in dealing with the obviousness test is set forth as follows in the last sentence of finding 17:

> 'The prior art as set forth in the above patents does not appear to be, both collectively and individually, the subject matter therein such as would make the patent in question obvious to a person having ordinary skill in the art.'

"As we have indicated above, this sentence appears to be the ultimate conclusion of law which the District Judge subsequently supported with this reasoning under the heading of Conclusions of Law:

> 'The state of the prior art has been indicated by the parties through the introduction in evi-

dence of nine patents. They fall naturally into two categories; those of modern origin concerned exclusively with a non-dumpable manually pushed sweeper, and those of the nineteenth century addressed primarily to the unique problems of that era. The teachings of the prior art do include elements of the patent in question. It would be difficult indeed to imagine a mechanical device for the removal of debris and the deposit of such debris in a receptacle for later emptying that would not follow certain basic physical principles. The combination, however, of such established elements with a useful and novel result does create a patentable device, even though the elements of the combination are old and well known.'

"The District Judge and appellants also rely strongly upon secondary considerations and the presumption of validity of a patent once issued:

'The secondary considerations referred to in Deere reinforce the non-obviousness of plaintiff's patent. The move to suburbia following World War II created the enormous and profitable home lawn and garden industry. The riding tractor made grass cutting chores substantially easier. There was needed only some device to remove the grass clippings after cutting during the summer and fallen leaves in the autumn. These tasks continued to be manual, time-consuming, and unpleasant. Defendant as a manufacturer of lawn mowers would have been at least cognizant of this problem. The fact is, however, that neither defendant nor anyone else solved this problem until plaintiff marketed its product and the depth of the felt need was immediately apparent. An increase in sales in excess of 6,000% is probably the best evidence available as to the commercial success of this invention.

'The law is clear that a patent once issued is presumed valid, (35 U.S.C. § 282) and that a

> heavy burden of proof rests upon the party attempting to prove invalidity. *Westwood Chemical, Inc.* v. *Owens-Corning, supra* [445 F.2d 911 (6th Cir. 1971)].'
>
> "Accepting, as we do, the findings of fact of the trial judge and the applicability of both the secondary considerations and the presumption just referred to, we are still unable to agree that the resulting product was "nonobvious" within the meaning of the constitutional and statutory scheme."

It is thus apparent that the Court of Appeals gave lip service only to the statutory presumption of patent validity. This, of course, is the very question this Supreme Court is now being asked to determine, that is: Where the District Judge has meticulously followed the mandates of the Supreme Court in considering evidence on the question of "obviousness" and, in the light of this evidence has made findings of fact which are fully accepted by the Court of Appeals, should the Court of Appeals thereafter substitute its opinion on the "ultimate question of law" for that of the District Judge when the patent is further bolstered by the statutory presumption of validity? Clearly the answer should be no.

This Supreme Court, therefore, is by this Petition being asked to lay down guide lines as to the statutory presumption of patent validity, 35 U.S.C. 282 (p. 31a), and its relationship to the test for obviousness, 35 U.S.C. 103. No such Supreme Court guide lines presently exist.

II. The Decision Below on the Question of Obviousness Was Inconsistent with Fundamental Principles Applied by the Sixth Circuit Itself.

In the court below the Court of Appeals, after accepting the District Judge's findings of fact, which findings included a detailed analysis of the nine prior art patents relied upon by Respondent as in anticipation of the patents in suit (pp. 5a to 7a), then made its own analysis of

these patents and apparently found enough similarities to enable it to conclude that while:

> ". . . no one of the prior art patents shows all of the features of the Parker sweeper in the same combination.
>
> "What we do hold is that the state of the art included all of these patents and that a skillful mechanic setting out to build a towable dumpable lawn sweeper to be used in connection with a lawn mower tractor in the early 1960's could accomplish his mission without adding any 'invention' to the art." (p. 24a.)

The Court of Appeals, however, having fully accepted the District Judge's findings as to the disclosures of these prior art patents, had no cause to consider these documents further because, not having found the District Judge's findings with respect thereto clearly erroneous, they were binding on it, *H. K. Porter Company* v. *Goodyear Tire & Rubber Company*, 437 F.2d 244, 246 (6th Cir. 1971), cert. den. 404 U.S. 885 (1971) which held that the clearly erroneous rule applies to findings based solely on documentary evidence.

The Sixth Circuit Court of Appeals has applied the test for obviousness laid down by the Supreme Court in *Graham* v. *John Deere Co.*, supra, a number of times, e.g., *Porter* v. *Goodyear*, supra; and *Kolene Corporation* v. *Motor City Metal Treating, Inc.*, 440 F.2d 77, 81 (6th Cir. 1971), cert. den. 404 U.S. 886 (1971). Having properly applied this test, and having made factual determinations, the District Judge may then resolve the legal question of whether the inventions were obvious to one skilled in the art, *Westwood Chemical, Inc.* v. *Owens-Corning Fiberglas Corp.*, 445 F.2d 911, 917 (6th Cir. 1971), cert. den. 405 U.S. 917 (1972). Thus, having accepted all of the District Judge's findings, including those relating to the prior art, which were the bases for his holding of nonobviousness, (and also those relating to the secondary considerations

referred to in *Graham* v. *John Deere Co.* — p. 20a), the statutory presumption of validity should have prevailed; this statutory presumption of validity should not be ignored nor passed over lightly.

III. The Decision Below on the Question of the Statutory Presumption of Validity Was Inconsistent with Fundamental Principles Applied by the Sixth Circuit Itself.

The Sixth Circuit Court of Appeals has, in the past, made it abundantly clear that there must be "evidence" to overcome the statutory presumption of validity; see, for example: *United States Gypsum Co.* v. *Dale Industries Inc.*, 383 F.2d 497 (6th Cir. 1967); *FMC Corporation* v. *F. E. Myers & Bro. Co.*, 384 F.2d 4 (6th Cir. 1967), cert. den. 390 U.S. 988 (1968); and *Panduit Corporation* v. *Stahlin Bros. Fibre Works, Inc.*, 430 F.2d 221 (6th Cir. 1970), cert. den. 401 U.S. 939 (1971).

In *U. S. Gypsum* v. *Dale*, supra, at p. 502, the Court of Appeals noted that it is up to a defendant to produce "sufficient evidence" to overbear the presumption of validity. It is "the evidence presented" which must work to overcome the presumption of validity, *FMC Corporation* v. *F. E. Myers Co.*, supra, at p. 9. It is up to a defendant to rebut the presumption of validity, *Panduit Corporation* v. *Stahlin Bros. Inc.*, supra, at p. 225.

All of the evidence and testimony in the instant case were considered by the District Judge and made the subject of findings of fact which were fully accepted by the Court of Appeals. These findings, these "factual determinations", properly enabled the District Judge to resolve the legal question of obviousness. The District Judge's findings of fact as to the teachings of the prior art patents are binding on the Court of Appeals unless clearly erroneous, *Westwood Chemical* v. *Owens-Corning*, supra, at pp. 915 and 917. And, as also noted in *Westwood Chemical* v. *Owens-Corning*, supra, at p. 914, "The law is clear that a patent

once issued is presumed valid, 35 U.S.C. 282, and that a heavy burden of proof rests on the party attempting to prove invalidity."

The Court of Appeals, in the instant case, did not apply these principles it so well laid out in its previous decisions as noted herein. In this it was in error.

CONCLUSION

The statutory presumption of validity must be recognized and given vitality. It attaches after the Patent Office considers many factors, including the question of obviousness, and resolves such factors in applicant's favor. A heavy burden rests on one who would upset it. Evidence must be produced and such is considered by the District Court. Findings of fact, based on such evidence and on which the legal question of obviousness is resolved, are binding on the Court of Appeals unless clearly erroneous. This includes those findings describing the effect of prior art patents on the question of obviousness, findings made after expert testimony thereon was heard. All of these principles have been recognized in earlier Sixth Circuit Court of Appeals decisions.

In departing from the principles laid down by the Supreme Court and even applied by the Sixth Circuit Court of Appeals in its earlier decisions, the Court of Appeals below erred; Petitioner clearly was entitled to have the District Judge's decision holding the patents valid, affirmed.

This petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX A

IN THE

DISTRICT COURT OF THE UNITED STATES
FOR THE SOUTHERN DISTRICT OF OHIO
EASTERN DIVISION

Civil No. 67-376

PARKER SWEEPER COMPANY,

Plaintiff,

v.

THE E. T. RUGG COMPANY,

Defendant.

(Filed March 4, 1972)

I

FINDINGS OF FACT

(1) This is an action for infringement of United States Patent No. 3035294 and Design Patent No. 194051. Both patents were granted jointly to Theophilus P. R. Stout and Warner Houser under the following circumstances: '294 was applied for on August 17, 1959. The patent was issued on May 22, 1962, for "Sweeper with hand actuated rear dumping debris receptacle" for the period ending May 21, 1979. Patent '051 was applied for January 18, 1960, and granted November 13, 1962, for "Lawn Sweeper," for a period of fourteen years to expire on November 12, 1974. Both patents relate to lawn sweepers; '294 to its structure and '051 to its appearance.

(2) Plaintiff Parker Sweeper Company is an Ohio corporation and is the owner by assignment of both of the foregoing patents. Defendant The E. T. Rugg Company, a division of A.T.O., Inc., is an Ohio corporation having a regular and established place of business located in Newark, Ohio, within the Eastern Division of the Southern District of Ohio.

(3) This Court has jurisdiction both as to the parties involved and the subject matter in accordance with Title 28, U.S.C.A. 1338(a) and 1400(b) and under the patent laws of the United States, Title 35, U.S.C.A., Sections 101, 102, 103, 271, 282, 283, 284 and 285.

(4) Patent '294 described a lawn sweeper designed to be pulled by a home garden tractor. It contains a pivoted dumping debris receptacle actuated by the pulling of a cord, which causes the receptacle to rotate in a counterclockwise fashion until emptied.

The sweeper consists of: "A cart frame having a pair of spaced upright side sections with axle means at the front and rear, such axle means supporting ground engaging wheels; a rotary work element carried by the front of the frame and arranged to sweep debris into an open front and open top debris receptacle, pivotally mounted between the frame sections; the pivotal support for the receptacle being so arranged that it is forward of the receptacle center of gravity so that when an operator sitting on the tractor seat pulls the cord attached to the top of the receptacle, such receptacle will automatically return to its debris-receiving position when the operator releases the cord."

(5) Of the four claims of the '294 patent, plaintiff relied at the trial only on claim 3, which is as follows:

> (3) A lawn sweeper comprising in combination a cart, including a frame, having spaced upright

side sections, axle means at the front of the frame, wheels on said axle means, axle means at the rear of the frame, wheels on the second mentioned axle means, a machine head carried by the front of the frame, between the side sections and including a rotatable work element; bearing means adjacent the top and rear of each section of the frame sections and disposed forwardly of the rear wheels, the axex of said bearing means being aligned and disposed transversely of the direction of movement of the cart on the wheels; an open front and open top debris receptacle disposed between the frame sections and including axle means cooperating with the bearing means for pivotally supporting the debris receptacle, the axle means for the debris receptacle lying forwardly of the center of gravity of the receptacle in all positions to which the receptacle can be moved.

(6) The design '051 patent claims the ornamental design and appearance of plaintiff's sweeper. It, in usual design patent fashion, contains a single claim which is as follows:

> "The ornamental design for a lawn sweeper as shown and described."

(7) Parker Sweeper Company and its predecessor have engaged in the manufacture of lawn sweepers since 1919. Early sweepers were hand pushed with a fixed debris receptacle. Such receptacle could only be emptied by overturning the sweeper or, when so equipped, by removing a bailing liner therefrom. Plaintiff had marketed a large sweeper pulled by a tractor. This sweeper was unsatisfactory for home use, since its size required a large tractor and two men to remove the debris collecting bailing liner.

(8) In 1960 plaintiff placed on the market its "Trailette," and "Hitch and Sweep" models. These models were identified at trial as plaintiff's exhibit 7 and defendant's exhibit B, respectively. Both models embody the teachings of the patents in question. At that time there were no other trailing dumpable lawn sweepers available for home use.

(9) Commercially, the models were a prompt and substantial success. From sales of non-dumpable trailing lawn sweepers of approximately 200 per year, the sales of plaintiff's sweepers increased to 13,000 per year. They satisfied a need in the home lawn garden market.

(10) Defendant began manufacturing a trailing dumpable lawn sweeper in 1966. Defendant's entire output is marketed by Sears Roebuck & Company under the brand name, "Craftsman." One of such sweepers was introduced at trial as Plaintiff's Exhibit 1.

(11) Plaintiff gave defendant actual notice in writing of its infringement of the patents '294 and '051 by letter dated August 25, 1967.

(12) Following such date, defendant continued to manufacture its trailing dumpable lawn sweeper and has manufactured it continuously to this date.

(13) There are presently five manufacturers of trailing dumpable lawn sweepers: Plaintiff, The Parker Sweeper Company; The E. T. Rugg Company, Defendant; Precision Products, Inc., holder of a license from plaintiff since 1968; Lambert, Inc., assignee of U. S. Patent No. 3597.786 and the Sarlo Corporation of Fort Myers, Florida.

(14) Precision Products, Inc. markets a Model TD-30-70 under a non-exclusive license under both of the patents in suit, granted by plaintiff in 1968.

(15) Defendant denies both validity of patent and infringement for the following reasons:

Appendix A

(a) The prior state of the art was such that each of the elements or mechanical equivalent thereof in plaintiff's patent may be found in prior patents and plaintiff's distinctions are mere mechanical design changes that would have been obvious to one having ordinary skill in the art.

(b) That portion of plaintiff's claim 3 which provides: "The axle means for the debris receptacle lying forwardly of the center of gravity of the receptacle in all positions to which the receptacle can be moved" has not been infringed by defendant's debris receptacle which can be rotated to positions where the center of gravity is moved forwardly of the axle means.

(16) A careful examination of patent '294 and those exhibits which demonstrated the device reveals that the trailing sweepers of both plaintiff and defendant consist of two functioning elements. Each has a brush rotating in a clockwise fashion, designed to remove debris from a lawn and a large canvas receptacle lying immediately behind said brush intended to collect the debris immediately after removal. Each sweeper is equipped with a cord enabling the debris receptacle to be rotated in a counterclockwise fashion until the debris, by force of gravity, drops to the ground. A release of the cord causes the receptacle to return to its initial position. Neither debris receptacle functions as such when placed in a position where its center of gravity is forward of the axle means. A device patented as a lawn sweeper should only be considered in the context of a functioning unit. Undeniably, defendant's sweeper is non-functioning whenever the center of gravity lies forward of the axle means.

(17) In support of its position denying the validity of plaintiff's patent, defendant has produced nine patents as

evidence of the state of the prior art. The parties have stipulated (R. 197) that such patents properly demonstrate the state of the prior art. These patents are as follows:

Patent No.	Inventor	Date	Exhibit No.
457693	Anderson	8/11/1891	A-4
517709	Tilton	3/3/1894	A-6
542571	Reynolds	7/9/1895	A-10
548659	Rogers	10/29/1895	A-11
703650	Gleason	7/1/1902	A-15
2700783	Parker, et al	2/1/1955	A-22
2727264	Dunham	12/20/1956	A-23
2737673	Parker, et al	3/13/1956	A-25
D151526	Parker	10/20/1948	A-27

These patents will be considered as follows:

(a) The four most recent patents, Parker 2700783, Dunham 2727264, Parker 2737673, and Parker D151526, each concern manually pushed lawn sweepers with fixed debris receptacles. They do not contemplate a pivotally supported debris receptacle. They suggest only the need for a better way to remove lawn debris. They do not require a detailed analysis.

(b) Patents Anderson 457693 and Reynolds 542571, Defendant's A-4 and A-10, relate to horse-drawn street sweepers. Tilton 517709 and Rogers 548659, defendant's exhibits A-6 and A-11, relate to manually pushed street sweepers and Gleason 703650, defendant's exhibit A-15, is concerned with an attachment for a lawn mower. These require a more detailed consideration.

The Anderson patent (A-4) operates in reverse of plaintiff's patent. The debris receptacle is forward of the rotating brush which operates in a counter-clockwise fashion and the bearing means for the debris receptacle is vertically movable in order to permit any dumping at all.

Reynolds (A-10) is also a horse-drawn street sweeper. It consists of a platform from which the various components are suspended rather than a pair of spaced upright side sections. This patent has but one set of wheels with a bearing means for the debris receptacle rearwardly of the rear wheels, as opposed to the position in plaintiff's patent where the receptacle is forward of the rear wheels.

Tilton patent 517709 (A-6) is a manually push street sweeper with a debris receptacle lying forward of the brush. The bearing means for pivotally supporting the debris receptacle are not at the top and rear of the side frame and a separate conveyor mechanism is utilized to carry debris from the brush upwardly and forwardly into the debris receptacle.

Rogers patent 548659 (A-11), is also a manually pushed street sweeper with a drive mechanism extending from the rotatable brush to the rear wheels of the sweeper. The "machine head" is not at the front of the side sections. The bearing means for the receptacle are not disposed near the top and rear of the side frame members. From an examination of this exhibit, it is clear that the debris receptacle is not an open top receptacle.

Gleason patent 703650, (A-15), is a lawn mower attachment. It performs no sweeping function. Clippings are deposited on a conveyor and moved upwardly and rearwardly until deposited in a receptacle. The bearing means for pivotally supporting the receptacle are disposed well rearwardly of the rear wheels of the device. Expert testimony at the trial indicated that in dumping the device the center of gravity of the receptacle was moved to a position forwardly of the axle means and to be returned to a debris-receiving position a rigid connecting link would be required.

The prior art as set forth in the above patents does not appear to be, both collectively and individually, the subject matter therein such as would make the patent in question obvious to a person having ordinary skill in the art.

(18) All of the nine patents relied upon by defendant as indicating the state of the prior art were classified by the United States Patent Office in the same classes and sub-classes as were the patents cited by the Patent Office Examiner during the prosecution of the application of the patent in question. No evidence was presented that the Examiner had not considered all of the patents cited prior to the approval of the patent in question.

(19) Precision Products, Inc., sought and received a non-exclusive license to manufacture a Trailette-type lawn sweeper. Rights were received by Precision Products under both the design and the structural patents until May 21, 1979, the expiration date of Patent '294 and four and one-half years after the termination of Patent '051. Design Patent '051 was not the significant patent in the agreement and an examination of plaintiff's exhibit 11 indicates that Precision modified the design itself to an extent comparable to defendant's design changes.

II

MEMORANDUM AND CONCLUSIONS OF LAW

Based upon the foregoing findings of fact, the Court determines the following conclusions of law:

(A) Patents 3035294 and 194051 are valid patents.

The tests for validity are set forth by statute. For a patent to issue there must be a finding of an invention which is new (35 U.S.C.A. §§ 101 and 102), useful (35 U.S.C.A. § 101) and "non-obvious" (35 U.S.C.A. § 103). See *Westwood Chemical Inc.* v. *Owens Corning Fiberglas*

Corp., 445 F.2d 911. Only the question of obviousness has been raised herein.

A three-step test has been established by the Sixth Circuit in determining the question of what constitutes "obviousness." *Westwood Chemical, Inc.* v. *Owens Corning Fiberglas Corp.*, 445 F.2d 911. The first step is a factual determination of the prior art; second, a factual determination of what, if any, improvement the patentee has made over the prior art; and third, a legal question of whether the improvement would have been obvious to one skilled in the art. Additionally, the Supreme Court in *Graham* v. *John Deere Company*, 383 U.S. 1 (1965), has indicated secondary considerations such as commercial success, long felt but unsolved needs, failures of others, etc., as relevant indicia of obviousness or non-obviousness. Such secondary considerations might also be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. The state of the prior art has been indicated by the parties through the introduction in evidence of nine patents. They fall naturally into two categories; those of modern origin concerned exclusively with a non-dumpable manually pushed sweeper, and those of the nineteenth century addressed primarily to the unique problems of that era. The teachings of the prior art do include elements of the patent in question. It would be difficult indeed to imagine a mechanical device for the removal of debris and the deposit of such debris in a receptacle for later emptying that would not follow certain basic physical principles. The combination, however, of such established elements with a useful and novel result does create a patentable device, even though the elements of the combination are old and well known. *Simplicity Manufacturing Co.* v. *Quick Manufacturing, Inc.*, 355 F.2d 1012 (6th Cir.

1966); *Williams Manufacturing Company* v. *United Shoe Machinery Company*, 316 U.S. 364 (1942); *National Latex Products* v. *The Sun Rubber Company*, 274 F.2d 224 (6th Cir. 1959); *Pullman Co.* v. *Holley Manufacturing Co.*, 233 F.2d 71 (9th Cir. 1956), *cert. den.* 352 U.S. 952; *Maytag Company* v. *The Murray Corporation of America*, 318 F.2d 79 (6th Cir.).

Consideration of this problem by the Sixth Circuit in *Simplicity* evoked the following discussion:

> "We cannot say that the construction was the product of ordinary skill rather than inventive insight, since the record discloses that others without success, including the defendant, were attempting for some time to obtain a soil tilling machine which could be operated rearwardly without muscular effort. Others could have done it. It now looks simple. But the fact remains, none accomplished it before Kamlukin put together a combination of elements synchronized in a manner to achieve a result which for many years had been elusive to those trained in the art. . . . The fact that the problem was unsolved for so long in the face of all the industry's efforts over the years gives credence to plaintiff's contention that the Kamlukin combination was anything but obvious to those skilled in the art. It was Kamlukin's ingenuity and resourcefulness in combining the elements necessary which overcame the deficiences so long prevalent in the art. His ingenuity and resourcefulness brought about a result which the prior art inventors were unable to conceive or anticipate."

Similarly, plaintiff's patent synchronized elements of the prior art. But no one else had previously been able to do it.

The secondary considerations referred to in *Deere* reinforce the non-obviousness of plaintiff's patent. The move to suburbia following World War II created the enormous

and profitable home lawn and garden industry. The riding tractor made gross cutting chores substantially easier. There was needed only some device to remove the gross clippings after cutting during the summer and fallen leaves in the autumn. These tasks continued to be manual, time-consuming, and unpleasant. Defendant as a manufacturer of lawn mowers would have been at least cognizant of this problem. The fact is, however, that neither defendant nor anyone else solved this problem until plaintiff marketed its product and the depth of the felt need was immediately apparent. An increase in sales in excess of 6,000% is probably the best evidence available as to the commercial success of this invention.

The law is clear that a patent once issued is presumed valid, (35 U.S.C. § 282) and that a heavy burden of proof rests upon the party attempting to prove invalidity. *Westwood Chemical, Inc.* v. *Owens Corning, supra.* See, *Everwear, Inc.* v. *Wieboldt Stores, Inc.*, 427 F.2d 373 (7th Cir. 1970). There is a further presumption that patents not cited by the Patent Office but classified in the same classes and sub-classes as those which were cited are presumed to have been considered by the Patent Office and discarded as not pertinent. *Artmoore Company* v. *Dayless Mfg. Co.*, 208 F.2d 4 (7th Cir. 1954); *Elgen Mfg. Co.* v. *Grant Wilson, Inc.*, 285 F.2d 476 (7th Cir. 1961). The failure of the Patent Office to cite a prior art patent is not sufficient to establish obviousness. Such contention must be proved. *Preformed Line Products Co.* v. *Fanner Mfg. Co.*, 328 F. 2d 265 (6th Cir. 1964). The "heavy burden" imposed upon defendant in the proof of invalidity has not been sustained in this case. Tested by the standards in *Westwood Chemical, supra,* and *Deere, supra,* the Court finds that the patents in question are valid.

(B) The patent holder has not lost the protection of a valid patent by misuse thereof.

Weight has been attached to *Rocform Corporation* v. *Acitelli Standard Concrete Wall, Inc.*, 367 F.2d 678 (6th Cir. 1966) in claiming plaintiff has misused its patent. Reliance upon such authority is in this Court's opinion misplaced. We read *Rocform* as holding that a licensing agreement covering multiple patents cannot be used to extend the patent monopoly beyond the life of the most important patent. The fact situation herein is precisely the reverse. Defendant urges *Rocform* where the agreement terminates at the expiration of the most important patent. The design patent expires while the agreement is in effect; it is obvious that it is of substantially less importance than the structural patent. The design patent had such little interest to the licensee that the product marketed under the agreement differed markedly from that of plaintiff.

At the most, however, *Rocform* would require only a reformation of the license agreement and not a holding of patent invalidity. As the Court observed:

> "The license agreement can, of course, readily be amended. It seems clear to us that the district judge was correct in denying plaintiff the use of the equity powers of the Court until and unless it purges itself of the practice identified above as representing patent misuse. Citing *Preformed Line Products Co.* v. *Spanner Manufacturing Co.*, 225 F.Supp. 762 (N.D. Ohio 1962), *aff'd.* 328 F.2d 265 (6th Cir. 1964), *cert. den.* 379 U.S. 846.

For the reasons stated above, no such reformation will be required herein.

(C) Plaintiff's patent has been infringed by defendant.

The determination of infringement is basically one of substance rather than form. Words such as "equivalent"

or "substantial similarity," have been used to describe this concept. The question is not what minute similarities or differences the devices may have, but rather a consideration of the function and performance of each to discover whether one thing is substantially the same as another, if it performs substantially the same functions and in substantially the same way to obtain the same result. *Saco-Lowell Shops* v. *Reynolds*, 141 F.2d 587; *Hunt* v. *Armour & Company*, 9 F.Supp. 767, *aff'd.* 185 F.2d 722; *U.S. Rubber Company* v. *General Tire and Rubber Co.*, 128 F.2d 106 (6th Cir.); *Swan Carburetor Company* v. *General Motors Corporation*, 43 F.Supp. 499 (N.D. Ohio).

An infringer may not by making slight departures from limits set out in a claim, avoid such infringement. *Celluloid Corporation* v. *Libbey-Owens Ford Glass Company*, 40 F. Supp. 840; nor can an infringer retain the substance of an invention and thereby escape injunctive process. *U.S. Rubber Co.* v. *General Tire & Rubber Co.*, *supra.*

When considered in accordance with these authorities, the device of defendant is clearly an infringement. At most, defendant's device demonstrates changes of an insubstantial nature. Such changes do not interfere with the essential structure or the essential function. At most, they may be considered equivalents. Defendant, however, may not appropriate an invention through minor and insignificant changes in the device to avoid the patent. An infringement is established once a comparison of accused device with the patented one shows that both perform substantially the same functions in substantially the same way to obtain the same result. *F.M.C. Corporation* v. *F. E. Myers & Bro. Company*, 384 F.2d 4 (6th Cir. 1967).

Defendant's device does function in precisely the same fashion to achieve precisely the same results. It removes lawn debris by means of a brush, deposits it in a receptacle;

such receptacle can be emptied by a pull on a cord and returned to its original position by release of the cord. The arc of rotation is neither material nor substantially different. In any operating position, the plaintiff's and defendant's sweepers perform identical functions and it is in this context that clear infringement of a design patent does exist.

The standard for infringement of a design patent is in the eye of an ordinary observer. As such "ordinary observer," the Court finds beyond question that the designs are substantially the same in the general overall appearance. There is therefore an infringement also of the design patent. *Applied Arts Corporation* v. *Grand Rapids Metalcraft Corporation*, 67 F.2d 428 (6th Cir. 1933); *Tappan Co.* v. *General Motors Corporation*, 383 F.2d 888 (6th Cir. 1967); *Harris and Schaeffer* v. *Curtis Aero Car Company*, 69 F.2d 264 (5th Cir. 1934).

III

RELIEF

In accordance with the foregoing, the Court grants plaintiff the following relief:

(A) Damages:

35 U.S.C. § 284 places upon the Court a duty to award the claimant damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer together with interest and costs as fixed by the Court.

The existence of the Precision Products license assists the Court in this determination. By such license plaintiff in an arms length transaction had indicated its willingness to share the lawn sweeper market on a non-exclusive and non-limited basis. Plaintiff also indicated a reasonable

royalty therefor. The actual damages suffered by plaintiff is therefore a sum equal to five per cent (5%) of the factory net selling price of each trailing type sweeper structure manufactured by defendant on and after August 25, 1967. Defendant is hereby directed to submit to the Court within fifteen (15) days hereof a certified account of all such sweepers produced and the net selling price thereof. A subsequent supplementary order will be issued concerning interest and costs and the increase of damages, if any, as provided in said Section 284.

(B) Injunction:

Defendant, its officers, agents and employees, are hereby permanently enjoined from:

(1) Manufacturing, selling or offering for sale or use its trailing sweeper known as "Craftsman" or any other trailing sweeper manufactured by it under other trade name;

(2) Causing to be manufactured, sold or used or offered for sale or use any trailing sweeper embodying the construction of claim 3 of the '924 patent or Design Patent '051;

(3) Manufacturing, causing to be manufactured, selling, or offering for sale or use any product in infringement of Patent '924 and Design Patent '051;

(4) Otherwise directly or contributorily infringing claim 3 of the '924 patent or Design Patent '051.

It is so ORDERED.

United States District Judge

APPENDIX B

No. 72-1664

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

PARKER SWEEPER COMPANY,
Plaintiff-Appellee,

v.

THE E. T. RUGG COMPANY,
Defendant-Appellant.

Appeal From the United States District Court for the Southern District of Ohio

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Decided and Filed February 27, 1973.

Before: EDWARDS, CELEBREZZE and KENT, Circuit Judges.

EDWARDS, Circuit Judge. Appellant Rugg appeals from the District Court's findings of validity of two Parker Sweeper patents, Patent No. 3,035,294 (hereafter '294) and Design Patent No. 194,051 (hereafter '051), and from a judgment granting damages for infringement and enjoining Rugg from further infringement.

The crucial issue in this appeal concerning the '294 patent is whether or not Parker's combination patent for a towable, dumpable lawn-leaf sweeper is invalid because the invention it claimed was obvious under the then existing state of the art to one skilled in the art. Although the

issue is not without difficulty, we conclude that the combination patent '294 is invalid for obviousness.

At the outset we note that if the equities between these two adverse parties were all that was at issue, the balance in this record would strongly favor appellee Parker Sweeper for all the reasons cited by the District Judge. Appellant Rugg appeared to the District Judge (and appears to us) deliberately to have copied Parker Sweeper's commercially successful product. Appellant Rugg prevails not because of merit in its conduct, but because of the national policy of rewarding with patent monopoly only those advances which can properly be characterized as "inventions." U.S. Const. art. I, § 8; 35 U.S.C. §§ 101, 102, 103 (1970); *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225 (1964); *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941); *Hotchkiss* v. *Greenwood*, 52 U.S. (11 How.) 248 (1850).

The record in this case appears to us to present no important dispute of fact.

On the heels of the development of the small tractor and a lawn mower suitable for towing behind it, a need became apparent for a grass or leaf sweeper which could be similarly employed. Such sweepers were readily available in the art for adaptation to small tractors. But as the president of Parker Sweeper Company testified, they were difficult to dump, since most could be emptied only by turning them over or by lifting out some form of basket or bailing liner. Until Parker's sweeper (patented under the numbers '294 as to structure and '051 as to design) was placed on the market, there was no sweeper which the tractor operator could operate and dump at a desired spot without dismounting. With the production and marketing of Parker's '294 sweeper beginning in

1960, its sales of sweepers skyrocketed from 200 per year to over 13,000 per year. Understandably, Parker was concerned when appellee Rugg Company in 1966 began to manufacture a very similar sweeper and to sell it to Sears, Roebuck under the latter's Craftsman label. After warning Rugg of its claims of patent infringement, Parker began the instant litigation by a complaint alleging infringement by Rugg of both its patents and seeking injunctive relief and damages.

The case was tried fully and it appears to this court that only legal issues remain. With the exception of the last sentence of finding 17 (which we believe to be a conclusion of law), we accept the careful findings of fact of the District Judge. They certainly are not "clearly erroneous"—the standard by which we review them. FED. R. CIV. P. 52; *American Saint Gobain Corp.* v. *Armstrong Glass Co.*, 434 F.2d 1216, 1218 (6th Cir. 1970).

As we have indicated, we also agree with the District Judge that the Parker sweeper met the test of utility fully and had sufficient differences in its method of combination of previously known elements to pass the test of novelty.

Nor do we find any fault with the District Judge's statement of the law applicable to a determination of "obviousness":

> A three-step test has been established by the Sixth Circuit in determining the question of what constitutes "obviousness." *Westwood Chemical, Inc.* v. *Owens-Corning Fiberglas Corp.*, 445 F.2d 911 [6th Cir. 1971]. The first step is a factual determination of the prior art; second, a factual determination of what, if any, improvement the patentee has made over the prior art; and third, a legal question of whether the improvement would have been obvious to one skilled in the art. Additionally, the Supreme Court in *Graham*

> v. *John Deere Company*, 383 U.S. 1 (1965), has indicated secondary consideration such as commercial success, long felt but unsolved needs, failure of others, etc., as relevant indicia of obviousness or non-obviousness. Such secondary considerations might also be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

The rationale of the District Judge and of the appellees in dealing with the obviousness test is set forth as follows in the last sentence of finding 17:

> The prior art as set forth in the above patents does not appear to be, both collectively and individually, the subject matter therein such as would make the patent in question obvious to a person having ordinary skill in the art.

As we have indicated above, this sentence appears to be the ultimate conclusion of law which the District Judge subsequently supported with this reasoning under the heading of Conclusions of Law:

> The state of the prior art has been indicated by the parties through the introduction in evidence of nine patents. They fall naturally into two categories; those of modern origin concerned exclusively with a non-dumpable manually pushed sweeper, and those of the nineteenth century addressed primarily to the unique problems of that era. The teachings of the prior art do include elements of the patent in question. It would be difficult indeed to imagine a mechanical device for the removal of debris and the deposit of such debris in a receptacle for later emptying that would not follow certain basic physical principles. The combination, however, of such established elements with a useful and novel result does create a patentable device, even though the elements of the combination are old and well known.

Appendix B

The District Judge and appellants also rely strongly upon secondary considerations and the presumption of validity of a patent once issued:

> The secondary considerations referred to in Deere reinforce the non-obviousness of plaintiff's patent. The move to suburbia following World War II created the enormous and profitable home lawn and garden industry. The riding tractor made grass cutting chores substantially easier. There was needed only some device to remove the grass clippings after cutting during the summer and fallen leaves in the autumn. These tasks continued to be manual, time-consuming, and unpleasant. Defendant as a manufacturer of lawn mowers would have been at least cognizant of this problem. The fact is, however, that neither defendant nor anyone else solved this problem until plaintiff marketed its product and the depth of the felt need was immediately apparent. An increase in sales in excess of 6,000% is probably the best evidence available as to the commercial success of this invention.
>
> The law is clear that a patent once issued is presumed valid, (35 U.S.C. § 282) and that a heavy burden of proof rests upon the party attempting to prove invalidity. *Westwood Chemical, Inc.* v. *Owens-Corning, supra* [445 F.2d 911 (6th Cir. 1971)].

Accepting, as we do, the findings of fact of the trial judge and the applicability of both the secondary considerations and the presumption just referred to, we are still unable to agree that the resulting product was "non-obvious" within the meaning of the constitutional and statutory scheme.

We believe this record and the District Judge's findings require the conclusion that *every* element critical to this patent was anticipated in one or more of the nine patents

as to which the parties stipulated. Although appellant's claims describe the sweeper brush and the mechanism which rotates it, it is too clear for argument that these features are anticipated by all nine of the described patents and many other sweepers.

The only "novelty" arguably described in the claims pertains to the dumping mechanism of the '294 sweeper. This is described in Claim 3:

> (3) A lawn sweeper, comprising in combination, a cart including a frame having spaced, upright side sections, axle means at the front of the frame, wheels on said axle means, axle means at the rear of the frame, wheels on the second mentioned axle means; a machine head carried by the front of the frame between the side sections and including a rotatable work element; bearing means adjacent the top and rear of each section of the frame sections and disposed forwardly of the rear wheels, the axes of said bearing means being aligned and disposed transversely of the direction of movement of the cart on the wheels; an open front and open top debris receptacle disposed between the frame sections and including axle means cooperating with the bearing means for pivotally supporting the debris receptacle, the axle means for the debris receptacle lying forwardly of the center of gravity of the receptacle in all positions to which the receptacle can be moved.

The '294 sweeper is pictured on opposite page—the top picture with the receptable in dumping position and the bottom in sweeping position.

Reduced to plain English, what this dumping device amounts to is a basket with an open top and front mounted on a frame behind a sweeper brush mechanism which propels swept debris into the basket. The basket is suspended from an axle mounted on pivots on the top part

of the frame so that the tractor operator may empty the loaded basket by pulling on a rope attached to the top of the rear side of the basket, thus causing the basket to tip or rotate forward on its axle, thereby dumping the debris through the open front of the basket. Upon release of the rope, the force of gravity returns the basket to its debris-receiving position.

Neither the basket, nor the frame, nor the axle, nor the pivot, nor the rope are claimed to be novel or patentable. The claim, of course, is that the combination of these elements as portrayed above is both ingenious and nonobvious, and that it met a felt need and achieved great commercial success.

We do not denigrate the importance of Parker's device merely because it is involved in the unglamorous task of waste removal. Waste removal is one of the most important of man's problems and its importance increases with the size of population and the complexity of our civilization. Waste removal is, however, also one of the most ancient of man's problems and as the District Judge noted, "It would be difficult indeed to imagine a mechanical

(ILLUSTRATION OMITTED)

Fig. 2

(ILLUSTRATION OMITTED)

Fig. 1

device for the removal of debris and the deposit of such debris in a receptacle for later emptying that would not follow certain basic physical principles."

Indeed, a number of the patents in the prior art demonstrated important aspects of Parker's combination.

Appendix B

The Anderson street sweeper (Pat. No. 457,693, District Court Exhibit A-4) shows gravity return of the receptacle after dumping. Specification forming part of Letters Patent No. 457,693, p. 2, lines 37-42, Aug. 11, 1891, Appendix p. 34.

The receptacle in the Tilton street sweeper (Patent No. 517,709, District Court Exhibit A-6) returned of its own weight to sweeping position after dumping. Specification forming part of Letters Patent No. 517,709, p. 1, lines 45-63, April 8, 1894, Appendix p. 38.

The receptacle employed in the Reynolds street sweeper (Patent No. 542,571, District Court Exhibit A-10) was "pivotably hung on pins secured in the sides of the frame." In addition its receptacle was adapted to "swing downwardly at its front end . . . and upwardly at its rear end to discharge the contents of the [receptacle] in the rear of the brushes between the wheels of the sweeper." Specification forming part of Letters Patent No. 542,571, p. 1, lines 54-64, July 9, 1893, Appendix p. 42.

In the Rogers street sweeper patent (Patent No. 548-659, District Court Exhibit A-11), the receptacle is referred to as the "receiver." Its function is described thus:

> The receiver 21 is adapted to be dumped at will, and for this purpose is mounted upon horizontal trunnions 22, supported on the ends of hangers 23, which project down from a crossbar 23^a on the main frame of the machine. This receiver 21 being thus adapted to be inverted may be moved to bring the receiving opening on the bottom, in order to empty its contents, by drawing a chain 24, whose upper end is held at convenient reach, as at 25. By the shape of the receiver 21 it is held in normal position by reason of its rear projection 26 and makes a tight connection with the collector 20 and receiver 21 and at the same time

affords a stop for the receiver in its return movement by curved edges 27, 28, against which the edges of the opening of receiver 21 abut. Specification forming part of Letters Patent No. 548,659, p. 1, lines 61-76, October 29, 1895, Appendix p. 48.

The Gleason lawn mower patent (Patent No. 703,650, District Court Exhibit A-15) discloses a dumpable receptacle which operates on much the same basic principle as the Parker dumping mechanism. Its receptacle follows the rotary mower which is towable. The dumping mechanism can be operated from the seat of a drawn mower. Dumping is accomplished, as it is with the Parker sweeper, by inverting the receptacle on its pivots. Specification forming part of Letters Patent No. 703,650, p. 2, lines 51-66, July 1, 1902, Appendix p. 57.

More could be added to this demonstration that every important element and every important function of the Parker sweeper had been employed in some machine at some time for some purpose. We do not ignore the facts that 1) frequently the receptacles referred to above were differently shaped to accomplish different purposes, 2) street sweepers operate differently from lawn sweepers, 3) hand pushed sweepers operate differently from power towed sweepers, and 4) that no one of the prior art patents shows all of the features of the Parker sweeper in the same combination.

What we do hold is that the state of the art included all of these patents and that a skillful mechanic setting out to build a towable dumpable lawn sweeper to be used in connection with a lawn mower tractor in the early 1960's could accomplish his mission without adding any "invention" to the art.

Appendix B

Article I, § 8 of the Constitution provides in part: "Congress shall have Power . . . To promote the Progress of Science and the useful Arts by securing for limited Times to . . . Inventors the exclusive Right to their respective . . . Discoveries." In pursuance of this authority Congress has adopted a statute which describes "invention" as to which a patent monopoly may issue in terms of "novelty," "utility," and "nonobviousness." 35 U.S.C. §§ 101, 102, 103 (1970).

We agree with the District Court that Parker's lawn sweeper passed the first two tests of novelty and utility. It still must survive the test of Sec. 103 which provides: "A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . ." 35 U.S.C. § 103 (1970). As Mr. Justice Black put the matter in 1964: "To begin with, a genuine 'invention' or 'discovery' must be demonstrated 'lest in the constant demand for new appliances the heavy hand of tribute be laid on each slight technological advance in an art.'" *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225, 230 (1964), and cases cited therein. It is against these standards that we review the validity of the instant patent and find it wanting.

As a matter of law, we hold that the Parker sweeper patent '294 is invalid because this record demonstrates a failure to meet the nonobviousness test of 35 U.S.C. § 103 (1970).

We likewise conclude that the Parker sweeper design patent '051 is invalid.

Appendix B

The statute under which this patent was issued provides:

§ 171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided. July 19, 1952, c. 950, § 1, 66 Stat. 805. 35 U.S.C. § 171 (1970).

In the leading case dealing with design patents the United States Supreme Court set the standards for review of patentability of a design:

> The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts . . . . And the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them. . . . It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. . . .
>
> We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer,

> inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other. *Gorham Co.* v. *White*, 81 U.S. (14 Wall.) 511, 524-25, 528 (1871).

The issue in *Gorham* was Gorham's claim that its design patent was infringed. But this court has applied the *Gorham* "ordinary observer" standard to the issue of validity of a design patent.

> A design patent must be possessed of novelty; the adaptation of old devices to new purposes, however convenient or useful they may be in their new role, is not invention. . . . The degree of difference required to establish novelty occurs when the average observer takes the new design for a different, and not a modified already existing design. . . . The fact that a design may be distinguished from those found in the prior art does not import the required novelty and ornamentation; its overall aesthetic effect must represent a step which has required inventive genius beyond the prior art. *Thabet Mfg. Co.* v. *Kool Vent Metal Awning Corp.*, 226 F.2d 207, 212 (6th Cir. 1955).

Appellants claim that Parker Sweeper's '051 patented design is extremely similar in appearance to two of Parker's own sweepers which had long been on the market. We reproduce below four exhibits, the first being the Parker Sweeper '051 design under the challenge and then three prior designs in the prior art:

(ILLUSTRATION OMITTED)

Parker Sweeper—Design Patent No. 194,051
D. C. Exh. 6.

Appendix B

(ILLUSTRATION OMITTED)

Prior Art. Parker Sweeper
Patent No. 2,700,783—D. Ct. Exh. A-22

(ILLUSTRATION OMITTED)

Prior Art. Parker Sweeper
Patent No. 2,737,673—D. Ct. Exh. A-25

(ILLUSTRATION OMITTED)

Prior Art. Dunham Sweeper
Patent No. 2,727,264—D. Ct. Exh. A-23

We recognize, of course, that the '051 design differed from the others in both size and framing. But tested by the *Gorham* standard as applied in *Thabet* to the eye of the ordinary observer, the designs must be regarded as substantially the same. *Gorham Co.* v. *White*, 81 U.S. (14 Wall.) 511 (1871); *Tappen Co.* v. *General Motors Corp.*, 380 F.2d 888 (6th Cir. 1967); *Thabet Mfg. Co.* v. *Kool Vent Metal Awning Corp.*, 226 F.2d 207 (6th Cir. 1955).

The judgment of the District Court is reversed and the case is remanded for entry of an order dismissing the complaint on the ground that both patents at issue are invalid.

APPENDIX C

PATENT LAWS

35 U.S.C. 101 et seq.

§ 101. Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§ 271. Infringement of patent.

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the

same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringment of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

§ 281. Remedy for infringement of patent.

A patentee shall have remedy by civil action for infringement of his patent.

§ 282. Presumption of validity; defenses.

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement, or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability.

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial. of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires. (Amended July 24, 1965, Public Law 89-83, sec. 10, 79 Stat. 261.)

§ 283. Injunction.

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

§ 284. Damages.

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the

use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

§ 285. Attorney fees.

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

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Supreme Court, U. S.
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MICHAEL RODAK, JR., CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1973

No. 72 - 1655

PARKER SWEEPER COMPANY,

Petitioner,

v.

THE E. T. RUGG COMPANY,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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INDEX

	PAGE
Opinions Below	1
Jurisdiction and Time Factors	1
Statutes Involved	2
Statement of the Case	2
Reasons for Denying Certiorari	7
I. Petitioner Did Not Timely Apply for the Writ in Accordance With Statutory Time Limits	7
II. The Limits and Effect of Statutory Presumption of Patent Validity Has Been Fully and Clearly Determined	10
III. Statutory Presumption of Patent Validity Is Not an Issue Requiring Review Under the Consideration Suggested in Supreme Court Rule 19	12
Conclusion	18
Appendix	
Order of Court of Appeals Denying Petition For Rehearing	A.1
United States Statutes	A.2
Supreme Court Rules	A.4

TABLE OF CASES

	PAGE
Eisele, d.b.a. Zero Internal Gage Company v. St. Armour, 423 F. 2d 135 (6th Cir.1970).....	17
Federal Trade Commission vs. Minneapolis-Honeywell Regulator Company, 344 U.S.206.....	9
Gorham Manufacturing Co. v. White, 81 U.S.411 (1871).....	16
Graham et al. v. John Deere Company of Kansas City, et al., 383 U.S.1 (1966).....	11
Kolene Corporation et al v. Motor City Metal Treating, Inc. 440 F.2d 77 (6th Cir. 1971).....	17
Westwood Chemical, Inc. v. Owens-Corning Fiberglass Corporation, 445 F.2d 911 (6th Cir.1971).....	17

TABLE OF STATUTES

28 U.S.C. 1254.....	2
28 U.S.C. 2101.....	2,7,8,9
35 U.S.C. 102.....	10,12,16
35 U.S.C. 103.....	10,12,16
35 U.S.C. 171.....	2,4
35 U.S.C. 282.....	10,11,12,13

TABLE OF SUPREME COURT RULES

Rule 19.....	2,12,18
Rule 22.....	2,8
Rule 34.....	2,7

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

OPINION OF COURT OF APPEALS

The opinion of the Sixth Circuit Court of Appeals in this litigation holding Petitioner's patents, Nos. 3,035,294 and Des. 194,051 invalid has now been reported at 474 F. 2d 950.

JURISDICTION AND TIME FACTORS

Review of the Court of Appeals judgment entered on February 27, 1973 is sought under the statutory provisions

of 28 U.S.C. 1254(1) in conjunction with the discretionary criteria stated in Supreme Court Rule 19. Petitioner applied for a writ of certiorari on June 9, 1973 by filing the present petition therefor on that date, a date twelve days beyond the ninety days time specified in 28 U.S.C. 2101 within which application must be made for a writ of certiorari.

STATUTES INVOLVED

This controversy involves one other specific patent statute in addition to those specifically noted by Petitioner. This statute is 35 U.S.C. 171, July 19, 1952, c.950, 1, 66 Stat.805, relating t patents for designs.

Timeliness of Petitioner's filing of the petition for a writ of certiorari is governed by 28 U.S.C. 2101 (June 25, 1948, c.646, 62 Stat.961; May 24, 1949, c.139 106, 63 Stat.104) in conjunction with Rules 22 and 34 of the Supreme Court Rules.

These statutes and rules are set forth in the Appendix.

STATEMENT OF THE CASE

The course of this litigation is that the District Court's judgment in favor of Petitioner Parker on Petitioner's patents, Nos. 3,035,294 and Des. 194,051, was reversed on appeal to the Sixth Circuit Court of Appeals with the case remanded for entry of an order dismissing the complaint against Respondent Rugg. Petitioner's complaint

filed in the District Court alleged infringement of both patents by Respondent. Respondent denied infringement and presented additional defenses of invalidity of the patents as being obvious in view of prior art and uninforcibility of the patent rights as a result of Petitioner's improper licensing practices as to these two patents constituting a misuse of the patent monopoly. The District Court held for Petitioner on all three issues with the Court of Appeals reversing the judgment holding that both patents were invalid. Since a holding of invalidity renders the issues of misuse and non-infringement moot, the Court of Appeals did not reach these two issues although both were before that Court for review. Accordingly, the issues of misuse and non-infringement are not properly reviewable at this stage of appeal proceedings and are reserved for decision by the Court of Appeals.

Petitioner has not accurately characterized the apparatus covered by the patents in suit. This inaccuracy is: (1) an omission of a further structural recitation that is included in each of the four claims of the mechanical structure patent No. 3,035,294; and (2) erroneous inference that the design patent, No. 194,051, also covers mechanical functional features.

With respect to the mechanical patent No. 3,035,294 (Pl. Ex. 5, R.21) each of the four claims includes a further structural relationship of the recited elements. This further specified structural relationship in the words of the claims is "**, the axle means for the

debris receptacle lying forwardly of the center of gravity of the receptacle in all positions to which the receptacle can be moved." In the context of Petitioner's paraphrasing of the lawn sweeper covered by the patents (but actually limited to the mechanical patent No. 3,035,294), this means that the receptacle is arranged on the cart frame and pivotal support to prevent pivotal movement other than within the specifically defined limits related to the receptacle's center of gravity. It is error to state on pages 3 and 4 of Petitioner's Petition that "the receptacle....will automatically return to its debris receiving position when the operator releases the cord" without including the aforesaid structural relationship required to make possible this automatic return.

Inference that the design patent covers the structural description paraphrased by Petitioner (see para. 3 on page 3 of Petitioner's Petition) is error although, in one instance, Petitioner does state that the design patent relates to appearance. Respondent suggests that it is more accurately appropriate to state that design patent No. 194,051 (Pl.Ex.6,R.21) covers the ornamental design of a lawn sweeper, as provided by 35 U.S.C. 171, which ornamental design is that design illustrated and described in the patent.

An apparent error on the part of the Patent Office printer resulted in failure to include a succintly comprehensive description of the design's characteristic features in the printed copies of the '051 design patent (Pl.

Ex. 6, R.21). While this error of the Patent Office initially hinders evaluation of the disclosure and determination of the extent of coverage of the design patent claim, resort to pp. 22 and 23 of the '051 design patent prosecution file adequately clarifies the matter of coverage for the protection of the public and determination of the issues in this litigation.

Respondent introduced and relied upon nine patents (Df.Ex. A-4,-6,-10, -11, -15,-22,-23,-25 and -27, R.154) as evidence supporting a determination that the two patents in suit were invalid under 35 U.S.C. 103 as obvious to one skilled in the art. (Note: Df.Ex.A-27 not considered by Court of Appeals). The District Court stated that these nine patents were classified in the same Patent Office art classification as were the prior art patents cited by the Examiner during prosecution of the patent in question (District Court Finding of Fact 18, p.8a of Petitioner's Appendix). With reference to Petitioner's statement of case (Petition p.5), it is submitted that this Finding of Fact indicates Petitioner clearly erred in making the unfounded supposition that these nine patents "were undoubtedly considered by the Examiner during his search." It is conceded that two of the nine patents which were specifically relied upon by Respondent to support a determination of invalidity of the '051 design patent were cited by the Examiner in initially rejecting the design claim and were obviously considered by the Examiner. The last sentence of the District Court's Finding of Fact 18 clearly shows

that this supposition is unfounded as is quoted as follows for immediate reference:

> "No evidence was presented that the Examiner had not considered all of the patents cited prior to the approval of the patent in question."

This quoted statement merely indicates no evidence was presented relative to an unknown matter and does not support Petitioner's inference that these patents were "undoubtedly considered by the Examiner during his search," excepting the aforementioned two patents specifically cited by the Examiner.

Petitioner places considerable emphasis on classification of the prior art in the Patent Office to substantiate its argument that the prior art relied upon by Respondent to demonstrate invalidity cannot be considered on review. Petitioner introduced as evidence of this classification an affidavit by its counsel (Pl.Ex.10,R.219) (Appendix p.16 in Court of Appeals) which indicated that these nine prior art patents, on January 14, 1972, were located in the same classification searched by the Examiner during the course of examining the patent applications which ultimately issued as the patents in suit. This fact that these prior art patents were located in these Examiner searched classifications in 1972 does not show that they were so located when the Examiner made his search in 1960 when the applications were in the Patent Office. The Patent Office is continually reclassifying art, and the Patent Office itself estimates that about 20% of the patents are reclassified each year. This point

was discussed in Respondent's reply brief at pages 6 and 7 filed in the Court of Appeals. The 12 year span between the Examiner's search and the search of Petitioner's counsel does provide a conclusive basis to assume that the nine prior art patents were in the art searched by the Examiner. In view of this practical aspect of classification, it is purely conjectural that all of the nine prior art patents were in the art searched by the Examiner, and the 1972 classification does not substantiate Petitioner's supposition that the prior art patents "were undoubtedly considered by the Examiner during his search."

REASONS FOR DENYING CERTIORARI

I. Petitioner Did Not Timely Apply For the Writ in Accordance With Statutory Time Limits

The time period within which application must be made for writ of certiorari is specifically prescribed in 28 U.S.C.2101 (A.2). Paragraph (c) of that section specifically states that a "writ of certiorari... shall be taken or applied for within ninety days after the entry of such judgment" sought to be reviewed. Petitioner seeks review of the Court of Appeals judgment entered February 27, 1973 that both patents in suit are invalid. The ninety day time period specified by Section 2101 expired on May 28, 1973; however, May 28 being a holiday, the time period was extended Under Supreme Court Rule

34 (A.6) to May 29, 1973.

Rule 22 of the Supreme Court Rules (A.5) also covers the time for filing of a petition for writ of certiorari. Part 3 of that rule is the applicable portion and states that "A petition for writ of certiorari in all other cases shall be deemed in time when it is filed with the clerk within the time prescribed by law." Section 2101 of Title 28 of the U.S.C. sets the time within which a petition shall be filed. The statutory prescribed time period of ninety days may be extended in accordance with that section 2101 (c) by a justice of the Supreme Court "for good cause shown." Since no extension has been obtained, Petitioneer cannot be said to have timely applied for a writ of certiorari by filing of a petition eleven days after the holiday-extended term of ninety days.

Petitioner did petition the Court of Appeals for rehearing on March 13, 1973. That petition was denied on April 16, 1973 by order of that Court filed on that date. The order denying the petition for rehearing merely stated that it did not appear any basis was presented to require further consideration of the matter. This general form denial is included in the Appendix (A.1).

It is submitted that a general denial by the Court of Appeals of a petition for rehearing, and without any change whatsoever to the judgment sought to be reviewed, does not operate to automatically extend the time. The act of filing a petition for rehearing with a general denial of that petition had no effect on the merits of the decision

and does not provide a basis for extending the time period for filing a petition for writ of certiorari as clearly prescribed by statute 28 U.S.C. 2101 (A.2). The principle that litigation must be ended at some definite point is succintly stated in Federal Trade Commission vs. Minneapolis-Honeywell Regulator Company, 344 U.S. 206; 97 L.Ed 245 (1952), although that case does not appear to have had a petition for rehearing filed on the issues sought to be reviewed, at p. 213:

> "***It is a principle reflected in the statutes which limit our appellate review jurisdiction to those cases where review is sought within a prescribed period. Those statutes are not to be applied so as to permit a tolling of their time limitations because some event occurred in the lower court after judgment was rendered which is of no import to the matters to be dealt with on review."

This principal is applicable in this case. Petitioner did not file this petition for writ of certiorari within the statutory prescribed time period of ninety days running from the date of entry of the judgment of the Court of Appeals. Petitioner did not seek extension of time in accordance with 28 U.S.C. 2101 (c). Hence, this statute requires that this litigation be considered terminated on May 29, 1973, and that this petition for a writ of certiorari be denied.

II. The Limits and Effect of Statutory Presumption of Validity With Respect to Patents Has Been Fully and Clearly Determined.

This statutory presumption of patent validity prescribed by 35 U.S.C. 282 is applicable only if the Patent Office grants a patent in accordance with all appropriate standards and criteria prescribed by statute, specifically those prescribed by 35 U.S.C. 102 and 103 (Petition Appendix, pp. 29a, 30a).

A determination by the Patent Office that an invention meets the standards and criteria for granting of a patent is a determination that is reviewable by the Federal Courts. It is without question that the issue of validity may be raised as a defense in a suit charging infringement and that this defense may be based on prior art patents. See part (2) and the last paragraph in 35 U.S.C. 282. (Petition Appendix, pp. 31a, 32a)

The prior art patents were introduced in evidence in this case to determine the invalidity of Petitioner's '294 and '051 patents on the basis of obviousness under 35 U.S.C. 103. Eight prior art patents were specifically reviewed in detail by the District Court and by the Court of Appeals in arriving at their respective conclusions on the issue of obviousness. Only two of these eight patents had been specifically cited and considered by the Patent Office, and those two only in connection with the design patent, No. 194,051.

Petitioner proposes that this is the question on review; Whether the

Court of Appeals could review the obviousness aspect after the District Court had concluded the patents to be valid and not obvious in view of the prior art. The apparent basis for this question is Petitioner's contention that the statutory presumption of validity under 35 U.S.C. 282 prevents independent review by the Court of Appeals of the obviousness aspect, admitted to be a question of law by Petitioner (Petition, p. 14, line 8 of the Conclusion).

Reviewability of the issue of obviousness is no longer a question open to further discussion. This is the precise issue litigated and reviewed by this Honorable Court in Graham v. John Deere Company, 383 U.S. 1 (1966). In that case, the Appellate Court evaluated the prior art, reviewed the obviousness aspect, decided the "ultimate question of law," and held invalid the patent that had been held valid by a lower court. The statutory presumption of validity was overcome in that case by a prior art patent which was not before the Patent Office in that it was not specifically cited during the course of prosecution.

It is submitted that the question now proposed by Petitioner is the same question that has been definitely answered in Graham v. John Deere, supra. Prior art not cited by the Patent Office was introduced in evidence for determining the issue of obviousness. After the patents in suit were held valid over prior art by the District Court, that some prior art was reviewed at the

appellate level, and it was concluded that the patents were invalid on the basis of obviousness. Graham uniquivocally supports Respondent's contention that clear guidelines have been provided by the Supreme Court as to the statutory presumption of validity and its relationship to the issue of obviousness. It is not necessary that this Honorable Court again consider the same question in the same context since no special and important reasons and no substantial questions have been presented meriting review under Supreme Court Rule 19 (A.4).

III. Statutory Presumption of Patent Validity is Not an Issue Requiring Review Under the Consideration Suggested in Supreme Court Rule 19.

It is most clear that Section 282 of Title 35, U.S.C., (Petition Appendix, p. 31a) states that a patent is presumed valid. The existence of that presumption is unquestioned.

It is equally clear and unquestioned that this presumption of validity is rebuttable. Section 282 lists the basis for challenging validity and includes asserting that any claim does not meet the conditions for patentability under part II of Title 35, which part includes Sections 102 and 103 (Petition Appendix, pp. 29a, 30a) The pertinent provisions of Section 102 are that a person is not entitled to a patent if the invention was patented in this country before invention by applicants for patent, or if the invention was patented in this country more than one year prior to the date of the application for patent. Section

103 adds the requirement of non-obviousness of the subject matter to a person having ordinary skill in the art relative to the differences between the subject matter sought to be patented and the prior art.

A factual basis must be presented to overcome this presumption of validity and Respondent did precisely that in the District Court. Evidence presented to provide this factual basis included nine U.S. patents (Df.Ex. A-4,-6,-10,-11,-15, -22,-23,-25 and -27, R.154). It will be noted here that Df. Ex. A-27 was not included in the Appendix filed in the Court of Appeals and was not specifically considered by that Court. Use of patents as evidence in sustaining invalidity is specifically contemplated by 35 U.S.C. 282 wherein the last paragraph of that section (Petition Appendix, p.32a) prescribes the procedure for noticing the patents which will be relied upon at trial.

These patents were properly noticed and introduced in evidence. Both Petitioner's and Respondent's expert witnesses commented on these patents, and the District Court made its evaluation and concluded that both patents in suit were valid. The Court of Appeals also had these nine prior art patents before it during review of this matter; and after independent evaluation, the Court of Appeals concluded that both patents in suit were invalid. Without question, nine prior art patents were introduced as evidence having direct bearing on rebutting of the statutory presumption of validity, and the disclosures of eight of these patents formed the basis of the Court of Appeals' determination that both patents

in suit were invalid.

With respect to patent No. 3,035,294, the Court of Appeals reviewed and commented on the Anderson, Tilton, Reynolds, Rogers and Gleason patents (Df.Ex. A-4, -6,-10,-11 and -15, respectively, R. 154) which constituted the five prior art patents relied upon by Respondent to rebut the presumption of validity and to support the conclusion of invalidity by reason of obviousness. The Court of Appeals, after making specific analysis and evaluation of these prior art patents, stated: (see Appendix pp. 24a and 25a in Petitioner's Petition)

> "What we hold is that the state of the art included all of these patents, and that a skillful mechanic setting out to build a towable dumpable lawn sweeper to be used in connection with a lawn mower tractor in the early 1960's could accomplish his mission without adding any "invention to the art."

Continuing, the Court of Appeals then stated:

> "As a matter of law, we hold that the Parker Sweeper Patent '294 is invalid because this record demonstrates a failure to meet the nonobviousness test of 35 U.S.C.§103 (1970)."

The Court of Appeals did not substitute its findings of fact for those of the District Court as to the prior art. The Court of Appeals reviewed the prior art and made additional findings of fact and then determined the legal question of obviousness. At the oral hearing the Court of Appeals commented that the District Court had not made sufficient findings to

support the District Court's holding on the issue of obviousness. This is clearly indicated in the Court of Appeals opinion (Petitioner's Appendix, p. 19a) where that Court, in referring to the last sentence of the District Court's finding 17, stated:

> "As we have indicated above, this sentence appears to be the ultimate conclusion of law which the District Judge subsequently supported with the reasoning under the heading of Conclusions of Law:..."

Subsequently, (Petitioner's Appendix, pp. 20a, 21a) the Court of Appeals further indicates that it did not substitute findings of fact by stating:

> "Accepting, as we do, the findings of fact of the trial judge and the applicability of both the secondary considerations and the presumption just referred to, we are still unable to agree that the resulting product was "non-obvious" within the meaning of the constitutional and statutory scheme.
>
> We believe this record and the District Judge's findings require the conclusion that every element critical to this patent was anticipated in one or more of the nine patents as to which the parties stipulated. Although appellant's claims describe the sweeper brush and the mechanism which rotates it, it is too clear for argument that these features are anticipated by all nine of the described patents and many other sweepers."

This leaves no question that the Circuit Court of Appeals based its determination

that the two patents in suit were invalid for obviousness, on the District Court's finding of fact and on its further findings and evaluation of the prior art.

Petitioner's design patent No. 194,051 was similarly considered in view of evaluation of three prior art patents (Df. Ex. A-22,-23 and -25, R.154) by the Court of Appeals. That Court then applied the standards for reviewing patentability of a design patent set by the Supreme Court in Gorham v. White, 81 U.S. (14 Wall.) 511, 524-25,528 (1871). The result of this review is summarized by the Court of Appeals statement: (see Appendix p. 28a of Petitioner's Petition)

> "We recognize, of course, that the '051 design differed from the others in both size and framing. But tested by the Gorham standard as applied in Thabet to the eye of the ordinary observer, the designs must be regarded as substantially the same."

The foregoing summary of the Court of Appeals review fully substantiates that Court's conclusion that both patents in suit were invalid as a matter of law in accordance with long accepted review standards as to patentability and pursuant to the statutory requirements of Sections 102 and 103 of Title 35. Factual determinations are the prior art patents presented as documents that speak for themselves. These facts do not require a separate summarization; a summarization which Petitioner proposes should be classified as a finding of fact that could only be determined by the District Court. The Court of Appeals

reviewed these factual determinations, the prior art patents, and followed long accepted review standards consistent with the Supreme Court and the Sixth Circuit. Consistency in the Sixth Circuit is adequately demonstrated in Westwood Chemical, Inc. v. Owens-Corning Fiberglass Corp., 445 F.2d 911 (6th Cir.1971) wherein the Sixth Circuit Court of Appeals, in applying the three step test in determining obviousness and referring to the third step of determining whether the improvement would have been obvious to one skilled in the art, stated:

> "this requires application of a legal criteria and therefore is a question of law, fully reviewable by the Appellate Court."

Consistency in the Sixth Circuit that this correct view of obviousness being a conclusion of law based on fact determinations and the lower courts'determination thereof fully reviewable is further demonstrated in Kolene Corporation et al. v. Motor City Metal Treating, Inc., 440 F.2d 77 (6th Cir.1971) and Eisele, d.b.a. Zero Internal Gage Company v. St. Amour, 423 F. 2d 135 (6th Cir. 1970).

Thus, the Court of Appeals' conclusion, as a matter of law, that the two patents in suit were invalid is not inconsistent with fundamental principles applied by the Sixth Circuit with respect to the question of statutory presumption of validity. The Court of Appeals holding of validity is simply the result of the presumption being overcome by the prior art evidence presented and does not present any special and important reason or substantial question

for review within considerations governing review on certiorari as stated in Supreme Court Rule 19.

CONCLUSION

Petitioner has failed to timely file its petition for writ of certiorari as prescribed by the applicable statutes, and this petition must therefore be denied. The questions proposed as meriting review, specifically, the effect of the statutory presumption of patent validity and appellate reviewability of the issue of obviousness, are questions that have been fully answered. Application to the specific situation of this case does not present any new questions, and the issues have been correctly determined by the Court of Appeals following the cited precedents. The Court of Appeals for the Sixth Circuit having followed the applicable precedents, has not erred. Since no special and important reasons and no substantial questions meriting review under Supreme Court Rule 19 has been presented, this petition should be denied.

Respectfully submitted,

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No. 72-1664

UNITED STATES COURT OF APPEALS

FOR THE SIXTH CIRCUIT

PARKER SWEEPER COMPANY, Plaintiff-Appellee,	Filed April 16, 1973
vs.	O R D E R
THE E. T. RUGG COMPANY, Defendant-Appellant.	

Before: EDWARDS, CELEBREZZE and KENT, Circuit Judges.

On consideration of the motions for rehearing and rehearing in banc filed in the above-styled case; and

No judge in active service in the court having moved for rehearing in banc, and the motion having been referred to the panel which heard the appeal; and

Said panel noting no fact or argument advanced in the motion for rehearing which had not been appropriately considered prior to the original decision,

Said motion for rehearing is hereby denied.

Entered by order of the Court

/s/ James A. Higgins
Clerk

UNITED STATES STATUTES

28 U.S.C. 2101

§2101. Supreme Court; time for appeal or certiorari; docketing; stay

(a) A direct appeal to the Supreme Court from any decision under sections 1252, 1253 and 2282 of this title, holding unconstitutional in whole or in part, any Act of Congress, shall be taken within thirty days after the entry of the interlocutory or final order, judgment or decree. The record shall be made up and the case docketed within sixty days from the time such appeal is taken under rules prescribed by the Supreme Court.

(b) Any other direct appeal to the Supreme Court which is authorized by law, from a decision of a district court in any civil action, suit or proceedings, shall be taken within thirty days from the judgment, order or decree, appealed from, if interlocutory, and within sixty days if final.

(c) Any other appeal or any writ of certiorari intended to bring any judgment or decree in a civil action, suit or proceeding before the Supreme Court for review shall be taken or applied for within ninety days after the entry of such judgment or decree. A justice of the Supreme Court, for good cause shown, may extend the time for applying for a writ of certiorari for a period not exceeding sixty days.

(d) The time for appeal or application for a writ of certiorari to

review the judgment of a State court in a criminal case shall be as prescribed by rules of the Supreme Court.

(e) An application to the Supreme Court for a writ of certiorari to review a case before judgment has been rendered in the court of appeals may be made at any time before judgment.

(f) In any case in which the final judgment or decree of any court is subject to review by the Supreme Court on writ of certiorari, the execution and enforcement of such judgment or decree may be stayed for a reasonable time to enable the party aggrieved to obtain a writ of certiorari from the Supreme Court. The stay may be granted by a judge of the court rendering the judgment or decree or by a justice of the Supreme Court, and may be conditioned on the giving of security, approved by such judge or justice, that if the aggrieved party fails to make application for such writ within the period allotted therefor, or fails to obtain an order granting his application, or fails to make his plea good in the Supreme Court, he shall answer for all damages and costs which the other party may sustain by reason of the stay. June 25, 1948, c.646,62 Stat.961; May 24, 1949, c.139, § 106,63 Stat.104.

35 U.S.C. 171

§171. Patents for designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent

therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided. July 19, 1952, c.950, 1, 66 Stat.805.

SUPREME COURT RULES

Rule 19. Considerations governing review on certiorari

1. A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor. The following, while neither controlling nor fully measuring the court's discretion, indicate the character of reasons which will be considered:

(a) Where a state court has decided a federal question of substance not theretofore determined by this court, or has decided it in a way probably not in accord with applicable decisions of this court.

(b) Where a court of appeals has rendered a decision in conflict with the decision of another court of appeals on the same matter; or has decided an important state or territorial question in a way in conflict with applicable state or territorial law; or has decided an important question of federal law which has not been, but should be, settled by this court; or has decided a federal question in a way in conflict with applicable decisions of this court; or has so far departed from the accepted and usual course of judicial proceedings,

or so far sanctioned such a departure by a lower court, as to call for an exercise of this court's power of supervision.

2. The same general considerations outlined above will control in respect of petitions for writs of certiorari to review judgments of the Court of Claims, of the Court of Customs and Patent Appeals, or of any other court whose determinations are by law reviewable on writ of certiorari.

Rule 22. Review on certiorari--time for petitioning

1. A petition for writ of certiorari to review the judgment of a state court of last resort in a criminal case shall be deemed in time when it is filed with the clerk within ninety days after the entry of such judgment. A justice of this court, for good cause shown, may extend the time for applying for a writ of certiorari in such cases for a period not exceeding sixty days.

2. A petition for writ of certiorari to review the judgment of a court of appeals in a criminal case shall be deemed in time when it is filed with the clerk within thirty days after the entry of such judgment. A justice of this court, for good cause shown, may extend the time for applying for a writ of certiorari in such cases for a period not exceeding thirty days. If the original judgment in such a case was entered in a district court in Alaska, Guam, Hawaii, Puerto Rico, the Virgin Islands, or the Canal Zone, the petition shall be deemed filed in time if

mailed by air-mail under a postmark dated within the thirty-day period or due extension thereof.

3. A petition for writ of certiorari in all other cases shall be deemed in time when it is filed with the clerk within the time prescribed by law.

4. An application for extension of time within which to file a petition for writ of certiorari must set out, as in a petition for certiorari (see Rule 23(1), subparagraphs (b) and (f), the grounds on which the jurisdiction of this court is invoked, must identify the judgment sought to be reviewed and have appended thereto a copy of the opinion, and must set forth with specificity the reasons why the granting of an extension of time is deemed justified. For the time and manner of presenting an application for extension of time within which to file a petition for writ of certiorari, see Rules 34, 35(2), and 50. Such applications are not favored.

Rule 34. Computation and enlargement of time

1. In computing any period of time prescribed or allowed by these rules, by order of court, or by any applicable statute, the day of the act, event, or default after which the designated period of time begins to run is not to be included. The last day of the period so computed is to be included, unless it is a Sunday or a legal holiday, in which event the period runs until the end of the next day which is neither a Sunday nor a holiday. A half holiday shall be considered as other days and not as a holiday.

2. Whenever any justice of this court or the clerk is empowered by law or under any provision of these rules to extend the time within which a party may petition for a writ of certiorari or docket an appeal or file any brief or paper, an application seeking such extension must be presented to the clerk within the period sought to be extended. Applications for extension of time to file petitions for certiorari or to docket appeals shall be submitted at least ten days before the expiration of the period sought to be extended and will not be granted except in the most extraordinary circumstances if filed during the last ten days of such period.

3. All applications seeking an extension of time within which a party may petition for a writ of certiorari or docket an appeal or file any brief or paper must be presented and served upon all other parties as provided in Rule 50, but such applications for extension of time, if once denied, may not be renewed before another justice after expiration of the period sought to be extended.

4. Whenever a justice or the clerk has granted an extension of time within which a party may petition for a writ of certiorari or docket an appeal or file any brief or paper it shall be the duty of the party to whom such extension is granted to give all other parties to the proceeding prompt notice thereof.

5. All applications for extension of time to file briefs, motions, appendices or other papers, to designate parts of records for printing in appendices, or otherwise to comply with time limits provided by these rules, except

applications for extensions of time to file petitions for certiorari, to docket appeals, to petition for rehearings or to issue mandates shall in the first instance be acted upon by the clerk, whether addressed to him, to the court or to a justice. Any party aggrieved by the clerk's action on such application may request that it be submitted to a justice or to the court.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 72-1655

PARKER SWEEPER COMPANY,

Petitioner,

v.

THE E. T. RUGG COMPANY,

Respondent.

PETITIONER'S REPLY BRIEF

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INDEX

	PAGE
Petitioner's Reply Brief	1-3
Respondent's Argument	1
Statute Involved	1, 2
Petitioner's Argument	1-3
Conclusion	4

TABLE OF CASES

PAGE

CITIZENS BANK OF MICHIGAN CITY, INDIANA, v. OPPERMAN, 249 U. S. 448 (1919) 3

LEISHMAN v. ASSOCIATED WHOLESALE ELEC. CO., 318 U. S. 203 (1943) 3

OTHER AUTHORITIES

West's Federal Practice Manual, Second Edition (Volz, 1970), Volume 7, Section 8844, pp. 314, 315, Certiorari—Time for Applying 2

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PARKER SWEEPER COMPANY,

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Respondent.

PETITIONER'S REPLY BRIEF

Petitioner, PARKER SWEEPER COMPANY, is filing this Reply Brief in accordance with Rule 24(4) of the Supreme Court Rules; it is addressed solely to an argument raised for the first time in "Respondent's Brief in Opposition to Petition for a Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit". Respondent's argument is that Petitioner did not apply for its Writ of Certiorari within the time limits prescribed by 28 U.S.C. 2101(c).

ARGUMENT

In its said Brief, Respondent argues that certiorari should be denied because: "I. Petitioner Did Not Timely Apply for the Writ in Accordance with Statutory Time Limits". It is respectfully submitted that this is a purely specious argument.

The judgment of the Court of Appeals for the Sixth Circuit was entered on February 27, 1973; Petitioner's timely filed Petition for Rehearing by that Court was filed on March 13, 1973; the said Petition was denied on April 16, 1973. Ninety days (Supreme Court Rules 10, 11, 13 and 22) from April 16, 1973 is July 15, 1973; the Petition for a Writ of Certiorari was docketed June 9, 1973, clearly well within the allotted time.

Respondent's only basis for arguing that the Petition for Writ of Certiorari was filed late is that the Petition for Rehearing must be ignored and the time counted from the original entry of judgment, not from the date of the denial of the Petition for Rehearing. Respondent cites no authority for this proposition. Such proposition is patently untenable.

In Volume 7 of *West's Federal Practice Manual*, Second Edition (Volz, 1970), Section 8844, pp. 314, 315, Certiorari—Time for Applying, it is stated:

> "In all other cases the statutes prescribe that the petition for certiorari must be filed within 90 days following the entry of the judgment and that this period of time may be extended for an additional 60 days."
>
> "The finality of a judgment is suspended if a timely petition for rehearing or reconsideration is filed, and the time is computed from the date in which the lower court acts on the petition."

This has long been the law. United States Statute 28 U.S.C. 2101(c), reproduced at page 2 of Respondent's appendix, is the successor to section 350 of Title 28 U.S.C., 1940 ed., substituting "ninety days" for "three months", see "Historical and Revision Notes" 28 U.S.C. 2101, p. 86. Under the older statute the Supreme Court held:

> "In so holding that court recognized the general rule that where a petition for rehearing, a motion for a new trial, or a motion to vacate, amend or modify a judgment is seasonably made and entertained, the time for appeal does not begin to run until the disposition of the motion." *Leishman* v. *Associated Wholesale Elec. Co.*, 318 U.S. 203 at 205 (1943).

In a still earlier case, the Supreme Court, also with respect to the effect of a still earlier statute using the "three months" language (Act of September 6, 1916, c. 448, 39 Stat. 726, 727, 728), held as follows:

> "Where a petition for rehearing is entertained the judgment does not become final for purposes of our review until such petition has been denied or otherwise disposed of and the three months' limitation begins to run from date of such denial or other disposition." *Citizens Bank of Michigan City, Indiana*, v. *Opperman*, 249 U.S. 448 at 450 (1919).

Furthermore, the Rules of Appellate Procedure also make it abundantly clear that Petitioner's Writ was indeed timely filed. Rule 40 sets forth the 14 day time period for filing the Petition for Rehearing; Petitioner complied with this rule. Rule 41(a) specifies that the timely filing of such a Petition will stay the mandate until disposition of the Petition, and Rule 41(b) provides for continuing the stay until final disposition by the Supreme Court; all of these Rules were properly complied with by Petitioner. Clearly the filing of a Petition for Rehearing is not a meaningless act. Not until there is a final disposition of such a Petition for Rehearing is there a final entry of the judgment appealed from.

CONCLUSION

For all of the foregoing reasons, therefore, it is respectfully submitted that Petitioner has timely filed its Petition for a Writ of Certiorari; such petition should not be denied on the basis that it was not timely filed.

Respectfully submitted,

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